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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,981	05/31/2002	Carson Thomas	112210XZ (GEMS0138PUS)	3813
61604	7590	06/30/2006	EXAMINER	
PETER VOGEL GE HEALTHCARE 3000 N. GRANDVIEW BLVD., SN-477 WAUKESHA, WI 53188			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/063,981	Applicant(s) THOMAS ET AL.	
	Examiner Natalie A. Pass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 31 May 2002. Claims 1-21 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 19 recites the limitation "said new associated anonymous identifier" in line 3; and

(B) Claim 20 recites the limitation "said patient files" in line 1.

There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-3, 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Zubeldia et al., United States Patent Number 6, 397, 224.

(A) As per claim 17, Zubeldia teaches a method of anonymizing medical data comprising:

extracting a patient identifier from a patient file (Zubeldia; column 5, lines 26-33);
searching a plurality of related pair identifiers contained in a pair list database for said patient identifier (Zubeldia; column 6, lines 54-56, column 6, line 66 to column 7, line 2);
retrieving an associated anonymous identifier paired to said patient identifier from one of said related pair identifiers (Zubeldia; column 7, lines 8-15);
replacing said patient identifier with said associated anonymous identifier to create an anonymous file (Zubeldia; column 3, lines 22-27).

(B) As per claims 18-21, Zubeldia teaches a method as analyzed and discussed in claim 17 above, further comprising:

generating a new associated anonymous identifier to pair with said patient identifier if said searching a plurality of related pair identifiers fails to find said patient identifier in said pair list database (Zubeldia; column 3, lines 10-15);

“updating” (reads on “appending”) said pair list database to include a new related pair identifiers comprising said new associated anonymous identifier and said patient identifier (Zubeldia; column 3, lines 39-49);

wherein said patient files are automatically received from a primary care network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9);

wherein said patient file is automatically received from a patient file development network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9).

(C) Apparatus claims 1, 3, repeat the subject matter of claims 17, 21, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 17, 21 have been shown to be fully disclosed by the teachings of Zubeldia in the above rejections of claims 17, 21 it is readily apparent that the system disclosed by Zubeldia includes the apparatus to perform these functions. As such, these limitations are rejected of the same reasons given above for method claims 17, 21, and incorporated herein.

(D) As per claim 2, Zubeldia teaches an apparatus as analyzed and discussed in claim 1 above, wherein

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each of said patient identifiers includes a patient confidential data (Zubeldia; column 2, lines 18-24).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zubeldia et al., United States Patent Number 6, 397, 224 as applied to claims 1 and 3 above, and further in view of Leveque et al., United States Patent Application Publication Number 2002/0128860.

(A) As per claim 4, Zubeldia teaches an apparatus as analyzed and discussed in claims 1 and 3 above.

Zubeldia fails to explicitly disclose an apparatus wherein said patient file development network comprises at least one image acquisition station.

However, the above features are well-known in the art, as evidenced by Leveque.

In particular, Leveque teaches an apparatus wherein said patient file development network comprises at least one image acquisition station (Leveque; paragraph [0058]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Zubeldia to include these limitations, as taught by Leveque, with the motivations of providing “computer services to collect, manage, analyze and report

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clinical, economic and epidemiological data and outcomes information (collectively, "patient data")" ... [in order to] ... "benefit the hospitals' research programs, and ... allow improved patient care" (Leveque; paragraph [0044]).

(B) As per claims 5-8, 11, Zubeldia teaches an apparatus as analyzed and discussed in claim 1 above.

Zubeldia fails to explicitly disclose an apparatus further comprising
said at least one primary care network including a hospital archive system;
at least one remote hospital clinic workstation storing said pair list database;
a research and development network in communication with said an anonymous file generator, said research and development network receiving said one or more anonymous files;
and

wherein said research and development network comprises at least one research and development workstation.

However, the above features are well-known in the art, as evidenced by Leveque.

In particular, Leveque teaches an apparatus further comprising
said at least one primary care network including a hospital archive system (Leveque; Figure 4, paragraph [0071]-[0072]);

at least one remote hospital clinic workstation storing said pair list database (Leveque; Figure 1, paragraphs [0044], [0049]);

a research and development network in communication with said an anonymous file generator, said research and development network receiving said one or more anonymous files (Leveque; Figure 5a, paragraphs [0049], [0077]); and

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wherein said research and development network comprises at least one research and development “terminal” (reads on “workstation”) (Leveque; paragraph [0044]).

The motivations for combining the respective teachings of Zubeldia and Leveque are as given in the rejection of claim 4 above, and incorporated herein.

(C) As per claim 9, Zubeldia and Leveque teach an apparatus as analyzed and discussed in claims 1 and 5 above further comprising

a patient file development network in communication with said at least one primary care network, said patient file development network sending said one or more patient files to said at least one primary care network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9).

(D) As per claim 10, Zubeldia and Leveque teach an apparatus for anonymizing medical data comprising:

a patient file development network, said patient file development network creating one or more patient files, each of one or more patient files including a patient identifier (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-33);

a primary care network in communication with said patient file development network, said at least one primary care network including a hospital archive system for storing said one or more patient files (Leveque; Figure 4, paragraph [0071]-[0072]);

an anonymization network system including a first communications input for receiving said one or more patient files, said anonymization network system including a pair list database storing a plurality of related pair identifiers, each of said plurality of related pair identifiers

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including one of said patient identifiers and an associated anonymous identifier (Zubeldia; column 3, lines 22-27; column 6, lines 54-56, column 6, line 66 to column 7, line 2, column 7, lines 8-15);

wherein said anonymization network system creates one or more anonymous files from said one or more patient files by automatically replacing each of said patient identifiers with its said associated anonymous identifier taken from said related pair identifiers (Zubeldia; column 3, lines 22-27, column 3, line 63 to column 4, line 4, column 5, lines 34-41, column 10, lines 6-15).

The motivations for combining the respective teachings of Zubeldia and Leveque are as given in the rejection of claim 4 above, and incorporated herein.

(E) As per claims 12-16, Zubeldia and Leveque teach an apparatus as analyzed and discussed in claim 10 above

wherein said first communications input receives said one or more patient files from said patient file development network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9);

wherein said first communications input receives said one or more patient files from said primary care network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9);

further comprising:

a research and development network in communication with said anonymization network system, said research and development network receiving said one or more anonymous files from said anonymization network system (Leveque; Figure 5a, paragraphs [0049], [0077]);

a pair list retriever to search said pair list database to find a first associated anonymous identifier paired with a first patient identifier (Zubeldia; column 6, lines 54-56, column 6, line 66 to column 7, line 2);

a pair list generator to create a new associated anonymous identifier to pair with a new patient identifier, said new associated anonymous identifier and said new patient identifier comprising a new related pair identifiers, said new related pair identifiers "updated" (reads on "added") to said pair list database (Zubeldia; column 3, lines 10-15, 39-49).

The motivations for combining the respective teachings of Zubeldia and Leveque are as given in the rejection of claim 4 above, and incorporated herein.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Rubin et al., U.S. Patent Number 6654724, Gilbert et al., U.S. Patent Application Publication Number 2002/0073099, Pettovello, U.S. Patent Number 6449621, Johansson, U.S. Patent Number 5606610, Tsukamoto et al., U.S. Patent Application Publication Number 2003/0029913, Sweeney, U.S. Patent Application Number 2002/0169793, Brackett et al., U.S. Patent Application Publication Number 2004/0078587, Iyengar et al., U.S. Patent Application Publication Number 2003/0208457, and Yang et al., U.S. Patent Number 7047235, teach the environment of anonymizing patient data.

9. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

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or faxed to: (571) 273-8300.

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

June 20, 2006



C. LUKE GILLIGAN
PATENT EXAMINER